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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hanno Syrbe

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EXAMINER

CASCA, FRED A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,170	Applicant(s) SYRBE, HANNO	
	Examiner FRED A. CASCA	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 11/18/2008 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 23 drawn to a “downloadable application” *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit

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the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs and applications claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Examples of acceptable language in computer-processing related claims :

1. “computer readable medium” encoded with _____
[a] “a computer program”
[b] “software”
[c] “computer executable instructions”
[d] “instructions capable of being executed by a computer”
2. “a computer readable medium” _____ “computer program”
[a] storing a
[b] embodied with a
[c] encoded with a
[d] having a stored
[e] having an encoded

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1-3, 7-8 and 13-16, 19-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6,477,461 B2) in view of Veerasamy et al (US 2004/0203855) and further in view of Marwell et al (2002/0196922) .

Referring to claim 1, Tanaka discloses a method for creating a collection of selected geographical positions (abstract and figures 1-2, col. 3, lines 11-20) using a mobile terminal having a geographical position system (abstract, col. 2, lines 59-67, and figure 1, “vehicle”, “navigation system for a vehicle”, note that the navigation system for the vehicle is mobile) and a memory for containing the collection of selected geographical positions (abstract, col. 1, lines 55-60, col. 2, lines 60-67, “memory”), the method comprising:

automatically obtaining or determining the current geographical position of the mobile terminal using information received from the geographical position system (figures 3-8, col. 2, lines 59-67, “for detecting the present position”, “GPS”, note that calculations in determining the address is done automatically. Further, any information used in the determining process is a information received from geographical position system); and storing the obtained position in the memory upon a user input (abstract and col. 1 lines 18-54, “when a user inputs a new location for registration, data of an input new location is stored in the rewritable memory”),

wherein said mobile terminal has a plurality of operating modes including one recording mode (abstract, col. 1, lines 55-60, col. 2, lines 60-67).

Tanaka does not specifically disclose storing the current geographic position in the memory upon detection of an input to store the current position as claimed.

Veerasamy discloses mobile station and storing the geographic location in the memory (Par. 7 and 11).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka in the format claimed for the purpose of providing an efficient geographical navigational system.

The above combination does not disclose the mobile terminal has a single key activation on the mobile terminal causes the current geographical position to be stored.

Marwell discloses a mobile terminal having a single key activation on the mobile terminal that causes information to be stored.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka in the format claimed for the purpose of providing an efficient geographical navigational system.

Referring to claim 2, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 1, further comprising the step of adding an attribute to the saved geographical position (abstract and figures 1-2, col. 3, lines 5-20, "travel route").

Referring to claim 3, the combo of Tanaka/Veerasamy/Marwell discloses a method according to claim 1 wherein the mobile terminal comprises at least one key and the user input to store a preset geographical position in the memory is carried out by pressing only one (inherent) the at least one key (figure 1, 9-10, inherent).

Referring to claim 7, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 1 wherein the mobile terminal is provided with means for communicating data to other terminals, further comprising the step of the mobile terminal sending geographical

positions stored in the memory to other terminals and/or receiving geographical positions from other terminals (figure 1, “11”, note that information sent among mobile users via SMS and voice including geographic information is inherent in mobile communication).

Referring to claim 8, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 7, wherein the mobile terminal has an RF or IR receiver/transmitter (inherent), further comprising the step of sending and/or receiving geographical positions via an RF or IR based communication channel (figure 1, GPS receiver).

Referring to claim 13, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 1 wherein “the attribute” comprises a time and date stamp and/or a sound file, and/or an image file (inherent), and or a motion video file, and/or a text file (figure 9-16).

Referring to claims 14-16 and 19-20, claims 14, 15, 16, 19 and 20 define a mobile terminal reciting features analogous to the features of the method of claims 1, 2, 4, 7 and 8 (as rejected above). Thus, the combo of Tanaka/Veerasamy/Marwell discloses all elements of claims 14, 15, 16, 19 and 20 (please see the rejection of claims 1, 2, 4, 7 and 8 above).

Referring to claim 21, the combo of Tanaka/Veerasamy/Marwell discloses the mobile terminal according to claim 14 wherein the means for storing a current geographical position in the memory upon a user input is a software application on the mobile terminal (Figures 1-3 5 and 9-14, note that means for storing any data in memory is inherently a software application).

Referring to claim 23, claim 23 define a mobile terminal and an application reciting features analogous to the features of the method of claim 1 (as rejected above). Thus, the combo

of Tanaka/Veerasamy/Marwell discloses all elements of claim 23 (please see the rejection of claim 1 above).

6. Claim 5, 6, 12, 17-18 and 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6,477,461 B2) in view of Veerasamy et al (US 2004/0203855) and further in view of Marwell et al (2002/0196922) in view of well known prior art (MPEP 2144.03).

Referring to claim 5, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 1, wherein the mobile terminal has means for performing mathematical operations.

Tanaka does not specifically disclose the step of performing statistical and/or probability analysis on the collection of geographical positions.

Examiner takes official notice of the fact using statistical and or probability analysis on the collection of geographical positions is well known in the art.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka by incorporating the well known concepts for the purpose of providing an efficient geographical navigational system.

Referring to claim 6, the combo of Tanaka/Veerasamy/Marwell and well-known art discloses the method according to claim 5, and further disclose the analysis preferably comprise analysis of area related density of geographical positions (well known), preferably selectively

within geographical positions with a given attribute or with attributes within a given group (well known).

Referring to claim 12, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 5 and further disclose the step of generating a map for illustrating the result of the statistical and/or probability analysis, preferably by generating and displaying a map of an area (inherent) with a given density or density range of geographical positions with a given attribute or with attributes within a given group (also see figures 9-16 and the corresponding paragraphs).

Claims 17, 18 and 22 are analogous to claims 5, 6 and 12. Thus they are rejected for the same reasons that claims 5, 6 and 12 are rejected.

Claims 24-27 are rejected for the same reasons that claims 5-6, 12 and 22 are rejected.

7. Claim 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6,477,461 B2) in view of Veerasamy et al (US 2004/0203855) and further in view of Marwell et al (2002/0196922) in view of Najafi (US 2004/0203843 A1).

Referring to claim 9, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 8.

The combo of Tanaka/Veerasamy/Marwell does not specifically disclose the mobile terminal is a mobile phone or a communicator for use in a wireless cellular communication

network and capable of sending and receiving text messages, further comprising the step of sending a text message including at least one geographical position from the memory, preferably including any associated attribute of the geographical position concerned, to one or more remote terminals.

Najafi discloses a mobile phone capable of sending and receiving text messages, which includes a location determination device and the location information can be transmitted as text (figures 1-2, abstract and paragraph 15).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka by incorporating the teachings of Najafi into that of Tanaka in the format claimed by applicant, for the purpose of providing convenience for users since a user then will use only one multi-purpose mobile phone that performs both location determination and telephone calls as well.

Referring to claim 10, the combo of Tanaka/Veerassamy/Marwell/Najafi disclose the method according to claim 9, and further disclose that one or more remote terminals are mobile phones or communicators, and one of the mobile phones or communicators functions as a server with a database of geographical positions (Tanaka, figure 1 and Najafi, figure 1).

Referring to claim 11, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 8.

Tanaka fails to disclose connecting to a cellular network as claimed by applicant.

Najafi discloses connecting a terminal with location determination features to a cellular network (fig. 1-2, paragraphs 15-16, 22, 24, 27).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka by incorporating the teachings of Najafi into that of Tanaka in the format claimed by applicant, conserving energy and efficient RF resource usage.

Response to Arguments

8. Applicant's arguments with respect to claims 1-3 and 5-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617